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22917 7590 04/16/2007 MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196			EXAMINER TRAN, THUY V	
			ART UNIT	PAPER NUMBER
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/608,309
Filing Date: June 27, 2003
Appellant(s): MOR ET AL.

Steven A. May
For Appellant

EXAMINER'S ANSWER

This is in response to the substitute appeal brief filed November 08, 2006 appealing from the Office action mailed September 07, 2005.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

- Claims 19-20 are allowed;
- Claims 2-3, 5-7, 9-10, and 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims;
- Claims 4, 11, 16, and 18 were previously canceled;
- Claim 15 is objected to as being improper dependent form for failing to further limit the subject matter of a previous claim, which is claim 8; and
- This appeal involves claims 1, 8, and 15.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The appellant amended claim 8 but did not clarify that the display screen claimed in claim 15 was not also claimed in claim 8 as stated in the appeal brief.

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(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially incorrect. The changes are as follows:

- whether claims 1, 8, and 15 are unpatentable under 35 U.S.C. 102(b) as being anticipated by Lipp; and
- whether claim 15 fails to further limit the subject matter of claim 8.

(7) Claims Appendix

Grouping of claims stated in section (7) at page 5 of the appellant's brief is no longer necessary.

The appealed claims include claims 1, 8, and 15.

(8) Evidence Relied Upon

5398022

LIPP

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Objections/ Improper dependent claim

9.1 Claim 15 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. While "The apparatus" is the preamble of the claim, the limitation

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“the display screen” which has been already recited in claim 8 does not constitute any further limitation. Therefore, the limitation claimed in claim 15 is not treated on the merits.

Claim Rejections - 35 USC § 102

9.2 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9.3 Claims 1, 8, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lipp (U.S. Patent No. 5,398,022).

With respect to claim 1, Lipp discloses, in Figs. 1-4, an apparatus and a corresponding method for controlling an illumination of a display screen (which is in display [50]) in a pager [5] (which is a portable wireless communication device as claimed) comprising (1) illuminating (via light source [60]; see Fig. 1) the display screen (which is in display [50]), (2) determining (via microcomputer [40] and exclusively via user; see Fig. 1; col. 3, lines 41-51 and 59-62) an illumination time parameter corresponding to a message displayed on the display screen (re. time parameter; see col. 3, lines 49-51; re. message displayed; see col. 3, lines 14-17; col. 5, lines 20-22; col. 6, lines 40-61), wherein the illumination time parameter is based on a type of message to be displayed (see col. 3, lines 49-51; col. 5, lines 20-22), and (3) maintaining the illumination of the display screen (which is in [50]) for a period of time that is based on the illumination time parameter (see col. 3, lines 49-51 and 56-62; col. 5, lines 20-22).

With respect to claims 8 and 15, Lipp discloses, in Figs. 1-4, an apparatus for controlling an illumination of a display screen (which is in [50]) in a pager [5] (which is a portable wireless

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communication device as claimed) comprising (1) a light source [60] (see Fig. 1) for illuminating the display screen (which is in [50]), and (2) a processor [40] coupled to the light source [60] (see Fig. 1) that couples power (via switches [70]; see Fig. 1) to illuminate the display screen (which is in [50]), determines (see col. 3, lines 41-51 and 59-62) an illumination time parameter corresponding to a message displayed (see col. 3, lines 14-17; col. 5, lines 20-22; col. 6, lines 40-61) on the display screen (which is in [50]), wherein the illumination parameter is based on a type of message to be displayed (see col. 3, lines 49-51; col. 5, lines 20-22), and maintains a coupling of power to the light source [60] for a period of time that is based on the illumination time parameter (see col. 3, lines 49-51 and 56-62; col. 5, lines 20-22).

(10) Response to Argument

With respect to Appellant's arguments on claim 1 that "Nowhere does Lipp teach any determining of an illumination time parameter corresponding to a message displayed on a display screen, wherein the at least one illumination time parameter is based on a type of message to be displayed, or an illumination of the display screen for a period of time that is based on an illumination time parameter that is so determined" in the second paragraph at page 6, and that "The time period that the display is illuminated is fixed and is unrelated to the message being displayed" in the third paragraph at page 6 of the Appellant's brief, it is respectfully submitted that the cited reference to Lipp clearly teaches (a step of) determining (via microcomputer [40] and exclusively via user; see Fig. 1; col. 3, lines 41-51 and 59-62) an illumination time parameter corresponding to a message displayed on the display screen (re. time parameter; see col. 3, lines 49-51; re. message displayed; see col. 3, lines 14-17; col. 5, lines 20-22; col. 6, lines 40-61), wherein the illumination time parameter is based on a type of message to

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be displayed (see col. 3, lines 49-51; col. 5, lines 20-22) and wherein the time period that the display is illuminated is not fixed but related to the message being displayed dependent on the type or length of the message(s) (see col. 5, lines 20-22; col. 6, lines 40-61). Therefore, claim 1 remains rejected as being anticipated by the teachings of Lipp.

With respect to Appellant's arguments on claim 8 that "As noted above, such a processor is not taught by Lipp as the illumination time taught by Lipp is merely based on a user actuation of a switch and not on a message parameter" in the first paragraph at page 8 of the Appellant's brief, it is respectfully submitted that the cited reference to Lipp teaches that the processor [40] and an exclusive switch actuation of the user determine the illumination time based on the message parameter (see col. 5, lines 20-22; col. 6, lines 40-61). Therefore, claim 8 remain rejected as being anticipated by the teachings of Lipp. Furthermore, claim 15, which is dependent on claim 8, is also rejected as being anticipated by the teachings of Lipp since its claimed limitation "the display screen" is contained therein.

With respect to Appellant's arguments on the objection of claim 15 in section "(v) Other rejections" that "Claim 8 teaches an apparatus for controlling illumination of a display screen in portable wireless communication device that includes a light source, for providing illumination for a display screen, and a processor coupled to the light source, which processor couples power to the light source to illuminate the display screen. Claim 15 claims the display screen that is illuminated by the light source. Appellants respectfully contend that claim 8 does not claim the display screen and accordingly respectfully submit that claim 15 does limit the subject matter of claim 8" at page 7 of the Appellant's brief, it is respectfully submitted that "the display screen" has been already recited in line 5 and/or in line 6 of claim 8. While the "apparatus" is the

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preamble of claim 15, the limitation "the display screen", which has been already recited in line 5 and/or line 6 of claim 8 upon which claim 15 depends on, does not constitute any further limitation. Therefore, claim 15 is objected to as being improper dependent form for failing to further limit the subject matter of a previous claim.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

THUY V. TRAN

T.T. 04/05/07

Conferees:

TIMOTHY P. CALLAHAN



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